

Application No.: 09/557,796  
Filing Date: April 25, 2000  
Amendment with RCE faxed January 14, 2004  
Page 4 of 7

Attorney Docket No.: 252/123  
(037002-0205)

Remarks

By this response, claim 99 has been amended to define Applicants' invention with greater particularity. These amendments add no new matter and are fully supported by the specification as filed (see, e.g., specification at page 5, lines 8-11, and at page 44, lines 8-16). Claims 101, 102, 108, 109, 130, 131, 133, 135 and 136 have been cancelled without prejudice in order to reduce the issues.

Accordingly, claims 99, 100, 103-105, 107, 132 and 134 are currently pending. The present status of all claims in the application, and current amendments thereto, are provided in the listing of claims presented herein beginning on page 2.

The rejection of claims 99-104, 107-109 and 131-134 under 35 U.S.C. § 102(b), as allegedly being anticipated by U.S. Patent No. 5,032,514 to Anderson *et al.* (hereinafter referred to as "Anderson"), is respectfully traversed. Applicants' invention, as defined by claim 99 as amended, distinguishes over Anderson by requiring a recombinant cell comprising two distinct recombinant nucleic acid molecules. Specifically, a first recombinant nucleic acid molecule encodes one or more polypeptides that convert a source compound to a target compound; and a second recombinant nucleic acid molecule that comprises a reporter gene and an inducible promoter that responds to the target molecule to provide a detectable signal.

In contrast, as acknowledged by the Examiner (see Office Action, Paper No. 24, at page 4, lines 20-21) Anderson's system uses native enzymes of an endogenous pathway, and does not teach the introduction of two distinct recombinant nucleic acid molecules as contemplated by the present claims.

Application No.: 09/557,796  
Filing Date: April 25, 2000  
Amendment with RCE faxed January 14, 2004  
Page 5 of 7

Attorney Docket No.: 252/123  
(037002-0205)

Claims 100, 103, 104, 107, 132 and 134, all ultimately depend from amended claim 99; and claims 101, 102, 108, 109, 131 and 133 have been cancelled herein. Thus, Anderson does not teach each and every element of any of the presently pending claims. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection of claims 99-104, 107-109 and 131-134 under 35 U.S.C. § 102(b).

The rejection of claims 99, 102, 104 and 105 under 35 U.S.C. § 102(b), as allegedly being anticipated by Wood and Ingram, *App. Env. Microbiol.* 58:2103-2110, 1992 (hereinafter referred to as "Wood"), is respectfully traversed. Applicants' invention, as defined by claim 99 as amended, distinguishes over Wood by requiring a recombinant cell comprising a recombinant nucleic acid molecule that comprises a reporter gene and an inducible promoter.

Wood does not teach a recombinant nucleic acid molecule of any kind containing an inducible promoter. Claims 102, 104 and 105, all ultimately depend from claim amended claim 99. Thus, Wood does not teach each and every element of any of the presently pending claims. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection of claims 99, 102, 104 and 105 under 35 U.S.C. § 102(b).

The rejection of claims 99-102, 107 and 134-136 under 35 U.S.C. § 102(b), as allegedly being anticipated by Badia *et al.*, *J. Biol. Chem.* 273:8376-8381, 1998 (hereinafter referred to as "Badia"), is respectfully traversed. Applicants' invention, as defined by claim 99 as amended, distinguishes over Badia by requiring a recombinant cell comprising a second recombinant nucleic acid molecule that comprises a reporter gene and an inducible promoter.

Application No.: 09/557,796  
Filing Date: April 25, 2000  
Amendment with RCE faxed January 14, 2004  
Page 6 of 7

Attorney Docket No.: 252/123  
(037002-0205)

Badia does not teach a recombinant nucleic acid molecule containing an inducible promoter and a reporter gene. Claims 100, 107, and 134, all ultimately depend from amended claim 99; and claims 101, 102, 135 and 136 have been cancelled herein. Thus, Badia does not teach each and every element of any of the presently pending claims. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection of claims 99-102, 107 and 134-136 under 35 U.S.C. § 102(b).

With respect to the amendments of claim 99, the Examiner has indicated that "if entered, Applicant's amendments would overcome the rejections of record under 35 USC 102" (see Advisory Action mailed October 24, 2003, on Continuation Sheet (PTOL-303) comments). Accordingly, Applicants respectfully request withdrawal of all prior art rejections of record of the pending claims under 35 U.S.C. § 102(b).

The rejection of claims 135 and 136 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite, is respectfully traversed. Applicants respectfully submit that the term is phrase "Yia-operon related polypeptides" is clear to one of skill in the art in light of the teachings of the specification. However, in order to advance prosecution, claims 135 and 136 have been cancelled. Accordingly, Applicants respectfully submit that this rejection of claims 135 and 136 under 35 U.S.C. § 112, second paragraph, is rendered moot.

The rejection of claims 135 and 136 under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention, is respectfully traversed. However, in order to advance prosecution, claims 135 and 136 have been cancelled. Accordingly, Applicants respectfully submit that this rejection of claims 135 and 136 under 35 U.S.C. § 112, first paragraph, is also rendered moot.

JAN. 14. 2004 5:09PM 858 792-6773 FOLEY AND LARDNER

NO. 7345 P. 18

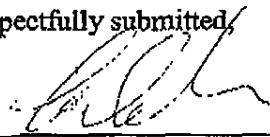
Application No.: 09/557,796  
Filing Date: April 25, 2000  
Amendment with RCE faxed January 14, 2004  
Page 7 of 7

Attorney Docket No.: 252/123  
(037002-0205)

Conclusion

In view of the above amendments and remarks, prompt and favorable action on all claims is respectfully requested. In the event any matters remain to be resolved in view of this communication, the Examiner is encouraged to call the undersigned so that a prompt disposition of this application can be achieved.

Respectfully submitted,



Date: January 14, 2004

Teresa Spehar  
Registration No. 51,281  
for Richard J. Warburg  
Registration No. 32,327

FOLEY & LARDNER  
Customer Number: 30542  
Telephone: (858) 847-6719  
Facsimile: (858) 792-6773